

Remarks/Arguments

In the present response, claims 1, 13 and 15 are amended; and claims 26 – 28 are newly added. Claims 8 – 11 and 18 were previously cancelled. Claims 1, 13 and 15 are independent.

The support for the claim amendments may be found in Applicants' specification, for example, page 3, lines 5 – 7; and Figs. 1 – 16, showing that there are intentional gaps or breaks in the numbering that allow for insertion of additional menu pages. No new matters are added.

Claim Objection

The Office Action objects to claim 13 for an informality. In the present response, claim 13 is reformatted to have additional indentations. Applicants submit that claim 13 as presented in the new format is clear. No new matter is added.

Withdrawal of the objection to claim 13 is respectfully requested.

Rejection of claims 13 and 14 under 35 U.S.C. 101

The Office Action rejects claims 13 and 14, alleging that the claimed apparatus is software per se. Applicants respectfully traverse.

For example, claim 13, in part recites: "for detecting a current menu page number of a menu page currently displayed." Applicants' specification, for example, page 8, lines 20 – 21, discloses that a menu page is a visible screen page of the menu. Applicants submit that a visible screen is clearly implemented in hardware. Also, claim 13, in part, further recites: "for determining from a request for displaying another menu page an allowed range of page numbers for the another menu page." Applicants' specification, page 9, lines 16 – 17, discloses that different buttons with which the user can navigate exist within the menu frames. Clearly, the user request is implemented in hardware. Therefore, the specification recites embodiments of the inventions that can be implemented in hardware. The present application does not state that the apparatus can be implemented only in software. Therefore, claims 13 and 14 are not software per se.

In addition, Applicants points to a recent BPAI decision in *Ex parte* William E. Mazzara Decided: February 5, 2009 that “[c]laims should be evaluated by their limitations, not by what they incidentally cover.” *In re Warmerdam*, 33 F.3d 1354, 1359 (Fed. Cir. 1994). Therefore, each of claims 13 and 14 includes a statutory subject matter. Withdrawal of this rejection is respectfully requested.

Rejection of claims 1 – 5, 12 - 17 and 19 – 25 under 35 U.S.C. 103(a) over Son et al. (US 2002/0041292, hereinafter Son) in view of Fender et al. (US 2004/0012382, hereinafter Fender) in further view of Oetzel et al. (US 2003/0227474, hereinafter Oetzel).

Applicants submit that for at least the following reasons, claims 1 – 5, 12 - 17 and 19 – 25 are patentable over the combination of Son, Fender and Oetzel.

For example, claim 1, in part, recites:

“determining a range of page numbers based upon said data associated with said command;

dynamically detecting available menu pages having page numbers within said range, wherein said dynamically detecting is performed each time said command associated with the first menu item is executed; and

selecting a second menu page upon activation of said first menu item, wherein the second menu page is one of the available menu pages and wherein the first and second menu pages are retrieved from different storage media.”

(Emphasis added)

In the Office Action, page 7, the Office concedes that Son does not disclose determining a range of page numbers based upon said data associated with said command; and detecting available menu pages having page numbers within said range; wherein the second menu page is one of available menu pages within the defined range of menu pages and wherein the first and second menu pages are retrieved from different storage media.

Fender discloses a method for application control in measurement devices (oscilloscopes, logic analyzers, spectrum analyzers etc.), wherein a new application is

installed using a graphical user interface, or GUI. A new menu item, a new toolbar button, a new measurement selection, etc., could be specified. However, upon installation of an application, “[t]he oscilloscope runs a batch file that terminates the operation of the oscilloscope, runs the application's installation program, and then reboots the oscilloscope. Terminating the operation of the oscilloscope and rebooting are required [...]” (see Fender, para.[0046]). That is, any addition of a new function, and thus a new menu item, requires rebooting the system, including the terminating of its operation. Since Fender requires rebooting and terminating the operation, the detection of available page cannot be performed dynamically each time the command is executed.

Further, Fender teaches that “[m]enu items may be added anywhere in the menu hierarchy” (see Fender, para. [0050]), and likewise “[t]he menu_path_string terminal is a string which specifies [...] the location in the existing oscilloscope menu hierarchy at which the new item is to be added” (see para. [0056]). This means that menu items may be added on the top level menu and on lower level menus. However, it does not mean that menu items may be added anywhere in the menu, and particularly not at any dynamically specified location in the specified hierarchy level, especially not between existing menu pages. Thus, Fender not only fails to teach or suggest “determining a range of page numbers”, but also fails to disclose “dynamically detecting available menu pages having page numbers within said range”. Therefore, Fender also fails to teach or suggest the above claimed features.

In the Office Action, pages 7 – 8, the Office alleges that Fender discloses determining a range of page numbers based upon said data associated with said command; detecting available menu pages having page numbers within said range; and selecting a second menu page upon activation of said first menu item, wherein the second menu page is one of the available menu pages. Applicants respectfully traverse.

Fender discloses the following: “a new menu item, [...] could be specified in the AppAccess.dat file” (see para.0048), and “At run time, when the oscilloscope reads the AppAccess.dat file, the oscilloscope associates the next available command identifier

with each successive new extension entry” (see para.0060). An exemplary data format of the AppAccess.dat file is shown in Fig.9. This suggests that the amount and sequential order of the menu items depends on the amount and sequential order of the entries in the “AppAccess.dat” file, as mentioned above. Further, Fender teaches that “terminating the operation of the oscilloscope and rebooting are required” and “the oscilloscope operating system 114 is re-launched” (see para.0046) after upgrading the software. This means that the menu is re-built from scratch according to the “AppAccess.dat” file after any modification, which makes any allocation of a menu page range useless because the menu structure cannot be changed before the next reboot. Allocation is a way to reserve any kind of resources for enabling dynamic modifications, in this case menu page numbers, and is used to prevent the necessity of rebooting. Therefore the arguments in the Office Action regarding allocated range of memory identifier do not imply the claimed features.

Furthermore, Applicants submit that if Fender would be combined with Son, the resulting solution would necessarily be different from the claimed invention. In particular, when extending a menu according to Fender that uses page numbers according to Son, then the menu items as shown in Fender’s Fig.6 would have hierarchical page numbers as shown in Son’s Fig.5. For example, Fender’s top menus “File”, “Control”, “Setup”, “Measure”, “Analyze”, “Utilities” and “Help” would be enumerated 1,2,3,...,7. The top level “Analyze” menu would have page number 5, and its sub-menus “Math/FFT” etc. would have page numbers 5-1, 5-2, etc. as suggested by Son’s Fig.5. Consequently, if menu items would be added, as shown in Fender’s Fig.7, then they would simply be appended to the existing menu (at a defined hierarchical level), as also shown in Fender’s Fig.7, and their page numbers would be obtained by increasing the last available menu item’s page number. That is, the “USB Test” and “PRML” menu items in Fender’s Fig.7 would get the page numbers 5-4 and 5-5. The page number would simply remain a descriptive element, without any control function with respect to the menu structure, since neither Son nor Fender suggests “determining a range of page numbers”.

Thus, even with a combination of the teachings of Son and Fender, the skilled person would not arrive at the claimed invention. Particularly at least “determining a

range of page numbers based upon said data associated with said command”, “dynamically detecting available menu pages having page numbers within said range” and “wherein the second menu page is one of the available menu pages” are not disclosed or suggested.

Applicants further submit that Oetzel does not in any way cure the deficiencies present in the combination of Son and Fender. Oetzel discloses authoring software (in particular, only “AuthorScript” is mentioned) that performs optimized recording of revisions on a rewritable interactive medium, wherein a minimum amount of file rewriting required to effect a desired revision is determined. Thus, Oetzel is only relevant for the authoring of rewritable media.

In view of at least the foregoing, Applicants submit that claim 1 is patentable over the combination of Son, Fender and Oetzel.

Independent claims 13 and 15 are different from and should be interpreted independent of claim 1. Since claims 13 and 15 each contains many similar distinguishing features as in claim 1, Applicants essentially repeat the above arguments for claim 1 and apply them to claims 13 and 15, pointing out why claims 13 and 15 are patentable. Claims 2 – 5, 12, 14, 16, 17 and 19 – 25 respectively depend from and inherit all the features of one of claim 1, 13 or 15. Therefore, claims 2 – 5, 12, 14, 16, 17 and 19 – 25 are patentable for at least the reason that they respectively depend from one of claim 1, 13 or 15, with each dependent claim containing further distinguishing features.

Rejection of claim 6 under 35 U.S.C. 103(a) over Son, in view of Fender, in further view of Oetzel, and in further view of Herle et al. (US 2002/0101459, hereinafter Herle).

Rejection of claim 7 under 35 U.S.C. 103(a) over Son, in view of Fender, in further view of Oetzel, and in further view of Escobar et al. (US 5,658,793, hereinafter Escobar).

Applicants submit that neither Herle nor Escobar can cure the deficiencies present in the combination of Son, Fender and Oetzel as discussed above with respect

to claim 1. Claims 6 and 7 respectively depend from and inherit all the features of claim 1. Therefore, claims 6 and 7 are patentable for at least the reason that they depend from claim 1, with each dependent claim containing further distinguishing features.

Withdrawal of the rejection of claims 1 – 7, 12 – 17 and 19 – 25 under 35 U.S.C. 103(a) is respectfully requested.

New claims 26 – 28 are patentable at least for the reason that they respectively depend from one of claim 1, 13 or 15, with each dependent claim containing further distinguishing features. .

Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicants' attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Respectfully submitted,
Dirk Gandolph, et al.

By: /Reitseng Lin/
Reitseng Lin
Attorney for Applicants
Registration No. 42,804

Patent Operations
THOMSON Licensing LLC
PO Box 5312
Princeton, NJ 08543-5312

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